

**REMARKS**

Applicants have noted and carefully studied the Examiner's comments and the cited art. Applicants respectfully traverse the rejections and request reconsideration. For the reasons set forth herein, Applicants submit that the claims are allowable as written. The undersigned wishes to thank the Examiner for the Examiner Interview on January 22, 2004 and February 2, 2004.

**§ 102(e) Rejections**

The Office Action rejects Claims 1-2, 5-6, 8, 15, 19-27 under 35 U.S.C. §102(e) based on Kanazawa et al. (6,580,870) ("Kanazawa"). Applicants respectfully traverse the rejection of the aforementioned claims.

The present invention relates to, *inter alia*, a method and system for enhanced random access media playback that modifies playback of random access media using the media-related data stream, wherein modified playback of the random access media produces an output data stream. For example, modifying playback may further include combining data resulting from playback of the random access media with additional content data included in the media-related data stream to produce the output data stream. (See Claim 8 and Claim 17). For example, the output data stream differs from a standard playback data stream associated with the random access media. (See Claim 9). According to one embodiment, modifying playback further comprises combining data resulting from playback of random access media with additional content data included in the media-related data stream to produce the output data stream. (See Claim 8). According to another embodiment, modifying playback further comprises executing commands included in the media-related data stream to produce the output data stream that differs from a standard playback data stream associated with the random acts of media. *Id.*

**Kanazawa**

Kanazawa is directed to a reproducing system that reproduces AV information from a storage medium, such as a DVD. (Kanazawa, ¶1, lines 56-59). The reproducing system is capable of only reproducing normal titles and acquiring related information connected with specific stream information from resources on a computer network. (Kanazawa Col. 1, lines 56-62, Abstract). The reproducing system provides a system that reproduces DVD video titles by the DVD standard without changing the standard and that realizes a new service where DVD video titles are combined with hypermedia contents, such as HTML files, provided on the Internet. (Kanazawa Col. 2, lines 1-7). Stream information presently being reproduced may be displayed on a window 95 on the screen 10a as shown in FIG. 11B. As shown in FIG. 11B, the home page 96 is displayed on the screen 10A of the display section 10 (Step 45). According, Kanazawa is limited to a CPU for generating the screen 10A including a window 95 and a home page 96. Kanazawa teaches after the reproduction of the title information is suspended, the modem is started and the CPU is connected to the Web server (Kanazawa ¶8, lines 13-16). After the home page has been displayed, the CPU cancels the connection with the NT resource or Web server and resumes the reproduction of the title information. (Kanazawa ¶8, lines 27-31). As a result, rather than teaching "modifying playback of random access media using the media-related data stream", Kanazawa teaches a CPU generating a screen 10A, including a window 95, and a home page 96 where the CPU1 suspends the reproduction of title information and, reproducing the stream information, and canceling the connection with the NT resource to resume the reproduction of the title information.

#### Claim 1

The Office Action equates Applicants' modifying playback of random access media using the media-related data stream, with the language contained in Kanazawa which as

described above is limited to a CPU for generating a screen 10A including a window 95 and a home page 96. Rather than “modifying playback of random access media using the media-related data stream wherein modified playback of the random access media produces an output data stream” Kanazawa instead teaches reproducing stream information on a window 95 and a home page 96. The applicants would like to point out the distinction between “modifying playback of random access media using the media-related data stream wherein modified playback of the random access media produces an output data stream” and the CPU, which reproduces stream information on a window 95 and a home page 96 on a screen 10A (Kanazawa ¶8, lines 6-10 and lines 24-26).

Further, Kanazawa states in part “after the reproduction of the title information has been suspended, the modem is started and the CPU 1 is connected to the Web server (step S50 to S52).” (Kanazawa, Col. 8, lines 13–16). “After the home page has been displayed, the CPU 1 cancels the connection with the NT resource (or Web server) and resumes the reproduction of the title information.” (Kanazawa, ¶8, lines 27–31). Applicants respectfully submit that the particular language of Kanazawa identified by the Office Action is limited to the reproduction of title information and the suspension of the title information in order to display a home page 96 on screen 100. The CPU 1 cancels the connection with the NT resource and resumes reproduction of the title information. (Kanazawa, ¶8, lines 27–31). As a result, the display of stream information 91 presently being reproduced may be cancelled and a home page displayed. (Kanazawa, Col. 8, lines 31–33). Applicants submit that the display of stream information being reproduced and canceled and then displaying the home page does not disclose, teach or suggest Applicants’ Claim 1 subject matter, specifically, “modifying playback of random access media using the media-related data stream.” As previously stated, Kanazawa is limited to the CPU for

reproducing title information in a display window without modification and suspending the reproduction of title information in order to display a home page 96 on screen 10A. (Kanazawa, ¶8, lines 8–10, and ¶8, lines 27–33).

Applicants direct the Examiner's attention to Kanazawa as cited for repeatedly describing reproducing the stream information (without modification) at ¶8, lines 8, 28, 34 and suspending the reproduction of title information ¶8, lines 6-7, ¶8, lines 14-16, to connect to the Web server. (Kanazawa, ¶8, line 6, lines 13–16). Further, since Kanazawa as cited teaches the display of stream information presently being reproduced (without modification) and then being canceled and the home page displayed, Kanazawa as cited teaches away from, *inter alia*, "modifying playback of random access media using the media-related data stream."<sup>1</sup> Accordingly, Kanazawa as cited fails to teach each and every element of the claims. Therefore, the Office Action fails to establish that Kanazawa as cited anticipates the claims.

Kanazawa explicitly requires that the reproduction of title information is suspended in order for the CPU to connect to the Web server in order to display the home page 96. (Kanazawa ¶8, lines 25-31). Kanazawa cannot modify what is being suspended. As such, Kanazawa teaches away from any modification of the title information since reproduction of title information is suspended.

Further, the Office action asserts "it is the Examiner's opinion that the reference meets the claim limitation as the 'playback' is modified using the 'media-related data stream' such that the normal playback image of media comprising a car (FIGS. 19A-19B) may be further modified to include Web-based content. (Office Action dated December 3, 2003, page 2, reference #2).

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<sup>1</sup> A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 U.S.P.Q. 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984), M.P.E.P. 2141.02.

However, contrary to the assertion in the Office Action, FIGS. 19A-19B as explained in Col. 7, lines 47-Col. 8, lines 46, describes the CPU1 suspending the (unmodified) reproduction of title information on window 95 in FIG. 11B and reproducing the stream information as home page 96, then canceling the reproduction of the stream information and resuming the reproduction of the title information rather than modifying the title information. Kanazawa merely suspends the title information and therefore does not modify the playback of the title information.

Kanazawa is limited to generating two images for reproducing either the title information on window 95 or the stream information (home page 96) rather than "modifying a playback of random access media using the media-related data stream, wherein modified playback of the random access media produces an output data stream." Applicants submit that Kanazawa neither discloses, teaches or suggests Applicant's claimed subject matter. Further, to the extent that Applicant teaches modifying playback of a random access media using the media-related data stream, Applicant's claimed subject matter is wholly different from that described in Kanazawa where Kanazawa describes the reproduction of either title information or stream information from a connection with a Web server. (Kanazawa Col. 8, lines 7-33).

Applicants submit that the reproduction of either the title information or the stream information from a Web server lacks the advantages present in Applicants' claimed subject matter. For example, the claimed "modifying playback of random access media using the media-related data stream" requires modifying playback of random access media wherein modified playback of the random access media produces an output data stream. Unlike Applicant's claimed subject matter, Kanazawa teaches suspending the reproduction of unmodified title information at Col. 8, lines 6 and 14 and separately displaying the home page 96 rather than "modifying a playback of random access media using the media-related data stream,

wherein modified playback of the random access media produces an output data stream.” Since Kanazawa requires that the CPU1 suspends the process of reproducing the present title information, Kanazawa cannot modify playback of random access media because the playback of the random access media to be played is itself suspended. Further, the process described in Kanazawa limits playback to either the unmodified title information or the display of stream information from a Web server rather than “modifying a playback of random access media using the media-related data stream, wherein modified playback of the random access media produces an output data stream”. (Kanazawa ¶8, lines 14-16). As a result, Kanazawa is referring to a completely different method with respect to the claimed elements as recited, namely, *inter alia*, “modifying playback of random access media using the media-related data stream.”

Taken into proper context, Kanazawa teaches the avoidance of “modifying playback of random access media using the media-related data stream” because the modification of the title information would require a more computationally complex process which teaches directly against “making effective use of and simple expansion of the DVD video standard.” (Kanazawa ¶20, lines 28-32). Kanazawa explicitly describes making effective use of and simple expansion of the DVD video standard rather than modifying playback of random access media using the media-related data stream. *Id* Therefore, taking the teachings of Kanazawa into proper context show that Kanazawa is limited to suspending the process of reproducing the present title information to display stream information. Accordingly, not only does Kanazawa teach away from “modifying playback of random access media using the media-related data stream, any modification to Kanazawa to modify playback of random access data using the media-related data stream would change the principal of operation of Kanazawa because such a modification would greatly increase the computations required and would result in the increased complexity

for which Kanazawa has sought specifically to avoid. (Kanazawa ¶21, lines 28-32). If Kanazawa fails to suggest “modifying playback of random access media using the media-related data stream,” it is because Kanazawa never contemplates the modification of the title information based on the stream information from the Web server. Additionally, Kanazawa teaches the simple use of the DVD standard without changing the standard, and as such teaches avoidance of “modifying playback of random access media using the media-related data stream.” (Kanazawa ¶2, lines 1-5).

Since Kanazawa teaches a different method as shown in Claim 1 and avoids the computations and the expense of “modifying playback of random access media using the media-related data stream,” the method taught by Kanazawa is unsatisfactory to anticipate Claim 1 and therefore teaches away from the claims. Applicants submit that the suspension of the reproduction of title information to play stream information from a Web server lacks the advantages described above such as “modifying playback of random access media using the media-related data stream” and also lacks other advantages present in Applicant’s claimed subject matter. Consequently, as the Office Action has similarly ignored a principal limitation of Claim 1, namely “modifying playback of random access media using the media-related data stream” and since Kanazawa does not disclose “modifying playback of random access media using the media-related data stream” as defined in Claim 1, Applicants submit that Kanazawa does not anticipate the invention as defined in Claim 1. Accordingly, reconsideration of the rejection of Claim 1 is respectfully requested.

#### GETSIN

Getsin describes the system and method for remote control of local content which enables the control of video playback from a remote server. (Getsin, ¶3, lines 61-63, ¶27, lines 38-41). Getsin provides a locking/unlocking scheme which allows content on a local disk 2106 or Web

cite to be protected and accessible to particular users at pre-described points in time through a locking/unlocking process. (Getsin ¶27, lines 56-58). With reference to FIG. 21, this control is performed by a transactional server 2102 which sends, video playback commands 2104 such as play, stop, fast forward, rewind, etc. (Getsin ¶27, lines 56-62). Therefore Getsin is limited to a system and method for remote control of local content rather than Applicant's claimed subject matter including "modifying playback of random access media using the media-related data stream, wherein modified playback of the random access media produces an output data stream." As such, Applicant submits that Getsin neither discloses, teaches or suggests Applicant's claimed subject matter.

Although the Office Action asserts that Getsin discloses examples wherein "a remote server is operable to 'control' and therefore modify the 'playback of random access media.'" The Office Action also asserts that Getsin describes "received information may subsequently alter the playback of the media citing Getsin Col. 27, lines 37-Col. 28, line 32. Contrary to the assertion in the Office Action that the received information may subsequently alter the playback of the media, Getsin merely describes the remote control of local content which sends video playback commands such as play, stop, fast forward, rewind, etc. (Getsin ¶27, lines 55-58). For example, Getsin describes content stored on a medium 2002 as shown in FIG. 20 such as a DVD is loaded onto a client device 2004. (Getsin ¶27, lines 41-42). Applicant submits that the Getsin language cited by the Office Action is limited to the control of a DVD rather than "modifying a playback of random access media using the media-related data stream, wherein modified playback of the random access media produces an output data stream." As such, the Applicant submits that Getsin neither discloses, teaches or suggests Applicant's claimed subject matter. (Getsin ¶27, lines 48-51).



Getsin describes the use of content 2012 and 2014 to be delivered from server 2010 to hardware 2004 to be used in conjunction with the DVD 2002 but fails to describe “modifying playback of random access media using the media-related data stream.” Additionally, Getsin states “control is performed by a transactional server 2102 which sends video playback commands 2104, such as play, stop, fast forward, etc.,” (Getsin ¶27, lines 56-58), which is limited to commands such as play, stop, fast forward, rewind, etc. rather than “modifying playback of random access media using the media-related data stream.” Further, to the extent that Applicant teaches “modifying playback of random access media using the media-related data stream,” Applicants claimed subject matter is wholly different from that of Getsin where Getsin merely describes playback commands such as play, stop, fast forward, rewind and access protection, and as such does not modify playback of random access media using the media-related data stream.

Applicants submit that the mere playback commands such as play, stop, fast forward, rewind, etc. lack the advantages present in Applicant’s claimed subject matter. For example, Applicant’s modifying playback of random access media may include commands in the media-related data stream to produce the output data stream that differs from a standard playback data stream associated with the random access media, as described with respect to Claim 9 for example. “Modifying playback of random access media using the media-related data stream” provides the advantage of modifying playback of random access media that may otherwise be different than the method taught by Getsin. Since the playback commands of Getsin are therefore limited to stop, fast forward and rewind, the method described in the Applicant’s claimed invention is wholly different than Getsin’s method. For example, if Getsin were modified in order to allow modification of playback of random access media rather than control

of video playback commands, then the system of Getsin would not function in a manner as taught by Getsin. Accordingly, taken into proper context, Getsin teaches the remote control of video playback and therefore, avoids “modifying playback of random access media” because the modification of the remote control of video playback would result in the inability of Getsin to remotely control video playback. Accordingly, not only does Getsin teach away from “modifying playback of random access media using the media-related data stream” any modification to Getsin to modify the playback of random access media would change the principal operation of Getsin because modifying the playback of random access media would defeat the specific objective of Getsin namely to remote control of local content which enables the control of video playback from a remote server.

Since Getsin teaches a different method than as shown in Claim 1 and is directed to an entirely different method of namely the control of video playback commands, the method taught by Getsin is unsatisfactory to anticipate Claim 1 and further teaches away from Claim 1. Applicants submit that the remote control of video playback taught by Getsin as shown in FIG. 20 ¶27, lines 56-58 lacks these and other advantages present in Applicant’s claimed subject matter. Consequently, as the Office Action has ignored a principal limitation of Claim 1, namely “modifying playback of random access media using the media-related data stream” and since Getsin does not disclose “modifying playback of random access media using the media-related data stream” as defined in Claim 1, Applicants submit that Getsin does not anticipate the invention as defined in Claim 1. Accordingly, reconsideration of the rejection of Claim 1 is requested.

#### **Dependent Claim 8**

According to the Office Action, Kanazawa teaches Claim 8 as illustrated in Figures 11A-B, referring to reference numbers 95 and 96, and ¶7, lines 48-¶8, line 9. The Kanazawa language

which states, "the stream information presently being reproduced maybe displayed on a window 95 on the screen 10A as shown in FIG. 11B. (Kanazawa, ¶8, lines 8-10). Then, as shown in FIG. 11b, the home page 96 is displayed on the screen 10A of the display section 10." (¶8, lines 24-27) which is limited to displaying either window 95 or home page 96 rather than "combining data resulting from playback of the random access media with additional content data included in the media related data stream to produce the output data stream. Since, however, Kanazawa teaches merely the display of either window 95 or home page 96, Kanazawa does not merge the two but merely displays the information and therefore Kanazawa fails to describe "combining data resulting from playback of the random access media with additional contents data included in the media related data stream to produce the output data stream. Rather than uniting or merging the window 95 and home page 96 to combine window 95 and home page 96, Kanazawa as cited instead teaches separately and individually displaying window 95 and home page 96. Applicants further submit that Claim 8 is also allowable in light of the presence of novel and non-obvious elements contained in Claim 8 that are not otherwise present in claim 1. Applicant also submits that Claim 8 depends from Claim 1, as dependent therefrom, Claim 8 is allowable for at least the reasons claimed 1 is allowable.

**Dependent Claims 2, 5, 12, 16, 17, and 18**

In response to the Office Action's objections to Claims 2, 5, 12, 16, 17, and 18, Applicants submit that these Claims depend from Claim 1 and, as dependent Claims therefrom, these Claims are allowable for at least the reasons Claim 1 is allowable. Applicants further submit that these Claims are also allowable in light of the presence of novel and nonobvious elements contained in these Claims that are not otherwise present in Claim 1.

**Dependent Claim 6**

The Office Action equates Applicants' "wherein the command data server is accessed using an address included on the random access media" with the language in col. 6 lines 37-50 which describes access information 30 to access a "WWW server using an "address" or URL that is included on the 'random access media.'" Applicants cannot find where Kanazawa as cited discloses "wherein the command data server is accessed using an address included on the random access media." Applicants incorporate the above remarks. Additionally, Applicants submit that Claim 6 depends from Claim 1 and, as a dependent Claim therefrom, Claim 6 is allowable for at least the reasons Claim 1 is allowable. Applicants further submit that Claim 6 is also allowable in light of the presence of novel and nonobvious elements contained in Claim 6 that are not otherwise present in Claim 1.

**Dependent Claims 9 and 11**

The Office Action equates Applicants' "wherein modifying playback further comprises executing commands included in the media-related data stream to produce the output data stream that differs from a standard playback data stream associated with the random access media" with the language in Getsin col. 27, lines 49-66, and col. 32, lines 32-40 which describes access to a WebTV and creating a TIFF that informs the user to place the DVD into a computer to access the special features and unlock the appropriate content. Applicants repeat the above comments with respect to Claim 1 asserting that Getsin fails to describe "modifying playback of random access media using the media-related data stream wherein modified playback of the random access media produces an output data stream." Applicants cannot find where Getsin as cited discloses "wherein modifying playback further comprises executing commands included in the media-related data stream to produce the output data stream that differs from a standard playback data stream associated with the random access media." Additionally, Applicants submit that Claims 9

and 11 depend from Claim 1 and, as dependent Claims therefrom, Claims 9 and 11 are allowable for at least the reasons Claim 1 is allowable. Applicants further submit that Claims 9 and 11 are also allowable in light of the presence of novel and nonobvious elements contained in Claims 9 and 11 that are not otherwise present in Claim 1.

#### **Independent Claim 15**

The Office Action equates Applicants' "modifying playback of a DVD inserted in the DVD drive using the DVD-related data stream, wherein modified playback of the DVD produces an output data stream provided to the video display over the display interface" with the language in Col. 15, lines 34-45. However, the cited language is limited to the display screen, as shown in FIG. 19B. (Col 15, lines 44-45). As such, the cited language does not appear to modify playback of a DVD wherein modified playback of the DVD produces an output data stream provided to the video display over the display interface. According to the cited language, Kanazawa plays back the DVD in an unmodified form. Additionally, Applicants repeat the previous remarks with respect to Claim 1 including the remarks regarding Kanazawa and Getsin. Applicants further submit that Claim 15 is also allowable in light of the presence of novel and nonobvious elements contained in Claim 15. Further, Kanazawa and Getsin as cited fail to describe each and every element as claimed. As a result, Kanazawa as cited fails to anticipate the claims.

#### **Dependent Claims 19 and 20**

In response to the Office Action's objections to Claims 19 and 20, Applicants submit that, because Claims 19 and 20 depend from Claim 15 and, as dependent Claims therefrom, Claims 19 and 20 are allowable for at least the reasons Claim 15 is allowable. Applicants further submit that Claims 19 and 20 are also allowable in light of the presence of novel and nonobvious elements contained in Claims 19 and 20, which are not otherwise present in Claims 15.

**Independent Claim 21 and Dependent Claim 23**

The Office Action equates Applicants' "a processor operably coupled to the random access media drive and the connection circuitry, wherein the processor receives a media-related data stream over the two-way connection, wherein the processor provides command codes to the random access media drive based on the media-related data stream" with the language in Col. 14, lines 13-15 and lines 15-41. The cited language is limited to executing a control program. (Col. 14, lines 13-15). As such, the Applicants cannot find where Kanazawa as cited teaches "wherein the processor provides command codes to the random access media drive based on the media-related data stream." As such, the cited language in Kanazawa does not describe "wherein the processor provides command codes to the random access media drive based on the media-related data stream."

Applicants repeat the previous remarks with respect to Claim 1. Applicants further submit that Claims 21 and 23 are also allowable in light of the presence of novel and nonobvious elements contained in Claims 21 and 23. Consequently, Kanazawa as cited fails to describe each and every element as claims. As a result, Kanazawa as cited fails to anticipate the claims.

**Dependent Claims 22, 24, 25, 26 and 27**

In response to the Office Action's objections to Claims 22, 24, 25, 26, and 27, Applicants submit that these Claims ultimately depend from Claim 21 and, as dependent claims therefrom, these Claims are allowable for at least the reasons Claim 21 is allowable. Additionally, Applicants repeat the previous remarks made above. Applicants further submit that these Claims are also allowable in light of the presence of novel and nonobvious elements contained in these Claims that are not otherwise present in Claims 21.

**§ 103(a) Rejections for Dependent Claims 3 and 4**

The Office Action states: "Claims 3—4 are rejected under 35 U.S.C. 103(a) over Kanazawa." (Office Action, Pg. 10, ¶7).

It is well-established that to establish *prima facie* obviousness, all the Claim limitations must be taught or suggested by the prior art. In addition, there must be some teaching, motivation or suggestion, in either the prior art or the references themselves, to make the combination asserted by the Examiner.

Firstly, the Office Action acknowledges that the Kanazawa reference does not explicitly disclose that the "random access media" may be a compact disc (CD) or a hard disk that stores video media data. Applicants repeat the above arguments and respectfully request the Examiner to withdraw the rejections. In addition, Applicants submit that Kanazawa does not disclose, teach or suggest, either implicitly or explicitly, Applicants' claimed subject matter. Secondly, as previously stated, since Kanazawa as cited teaches the display of stream information presently being reproduced being canceled and the home page displayed, Kanazawa as cited teaches away from, *inter alia*, "modifying playback of random access media using the media-related data stream."

As previously stated, Kanazawa teaches away from the claims and therefore there is no motivation to modify Kanazawa or otherwise implement such modification as a design choice in view of Kanazawa's explicit requirement that the media information is generated by a DVD. (Kanazawa, multiple references to DVD, 40 DVD, drive 4 at ¶4, lines 44-¶5, lines 21).

Applicants submit that Claims 3 and 4 depend from Claim 1 and as dependent claims therefrom, these claims are allowable for at least the reasons Claim 1 is allowable. Applicants further submit that Claims 3 and 4 are also allowable in light of the present and novel and non-obvious elements contained in Claims 3 and 4 that are not otherwise present in Claim 1.

As previously stated, a careful examination of Kanazawa reveals that, rather than teaching "modifying playback of random access media using the media-related data stream," Kanazawa as cited teaches the separate display of unmodified stream information presently being reproduced being canceled and the home page displayed. As such, since the previously described cited portions of Kanazawa teach away from the claims, one skilled in the art would not be motivated to modify Kanazawa, as suggested in the Office Action, to perform the modification as claimed. Consequently, the Office Action fails to establish a *prima facie* case of obviousness.

The Office Action states: "Claims 10, 13 and 14 are rejected under 35 U.S.C. §103(a) over Gets in. Applicants repeat the previous remarks made above. The Office Action acknowledges that Gets in does not explicitly disclose the use of a 'skip command to bypass scenes stored on the DVD.'" Further, the Office Action acknowledges that Gets in does not explicitly disclose the use of audio or textual data as part of the content. Consequently, the Office Action fails to show that the references teach each and every element of the claims.

Applicants respectfully request that the pending claims be allowed to issue. The Examiner is invited to contact the below-listed attorney if the Examiner believes that a telephone conference will advance the prosecution of this application.

Respectfully submitted,

By

  
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Date: February 3, 2004

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